

### **REMARKS**

The Examiner is thanked for the thorough examination of the present application. The Office Action mailed September 13, 2007 rejected claims 1-9 and 20-30. This is a full and timely response to that outstanding Office Action. Upon entry of the amendments in this response, claims 1-9 and 21-30 are pending. More specifically, claims 1, 21, and 30 are amended, and no new matter is added to the present application by these amendments. These amendments are specifically described hereinafter.

#### **I. Present Status of Patent Application**

Claims 1 and 30 are rejected under 35 U.S.C. 112, first paragraph as allegedly failing to comply with the written description requirement. Claims 1-2, 4-9, and 20-29 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by *Tsai* (U.S. Patent No. 6,839,741). Claims 3 and 30 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Tsai* (U.S. Patent No. 6,839,741) in view of *Cooper* (U.S. Patent No. 6,052,442). To the extent that these rejections have not been rendered moot by the amendment of claims, they are respectfully traversed.

#### **II. Examiner Interview**

Applicant first wishes to express sincere appreciation for the time that Examiner Sall spent with Applicant's representative Benjie Balser during a November 15, 2007 telephone discussion regarding the above-identified Office Action. During the interview,

various features described in the patent application and recited in the independent claims, including the email message having had all attachments that cannot be viewed on the email network appliance, were discussed, and that the outcome of this discussion is addressed herein. Applicant believes that the amendments presented herein are consistent with the suggestions and/or overall discussion with Examiner Sall. Thus, Applicant respectfully requests that Examiner Sall carefully consider this amendment and response.

### **III. Rejections Under 35 U.S.C. §112**

The Office Action rejects claims 1 and 30 under 35 U.S.C. §112, First Paragraph as allegedly failing to comply with the written description requirement. In an effort to address the Examiner's concerns, claims 1 and 30 have been amended to recite "the email message having had all attachments that cannot be viewed on the email network appliance." In view of this amendment, Applicant respectfully submits that the rejection of claims 1 and 30 should be withdrawn.

### **IV. Rejections Under 35 U.S.C. §102(e)**

#### **A. Claims 1-2, 4-9, and 20**

The Office Action rejects claims 1-2, 4-9, and 20 under 35 U.S.C. §102(e) as allegedly being anticipated by *Tsai* (U.S. Patent No. 6,839,741). For at least the reasons set forth below, Applicant respectfully traverses the rejection to the extent not rendered moot by amendment.

**Independent claim 1**, as amended, recites:

1. A method of manipulating email messages with an email network appliance comprising:

***receiving an email message with an email network appliance that can only provide the text of a message, the email message having had attachments that cannot be viewed on the email network appliance automatically deleted such that the email message is text only;***

classifying the text only email message;

inserting the text only email message into a classification container; and

presenting the classification container in a classification display section.

(Emphasis added).

Applicant respectfully submits that claim 1 is patentably distinct from the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that the amendments to claim 1 have rendered the rejection moot. Applicant respectfully submits that independent claim 1, as amended, is allowable for at least the reason that *Tsai* does not disclose, teach, or suggest at least **receiving an email message with an email network appliance that can only provide the text of a message, the email message having had attachments that cannot be viewed on the email network appliance automatically deleted such that the email message is text only**. Even if, assuming for the sake of argument, *Tsai* discloses removal of attachments from an email message, *Tsai* fails to teach receiving

an email message with an email network appliance that can only provide the text of a message, the email message having had attachments that cannot be viewed on the email network appliance automatically deleted such that the email message is text only. Therefore, *Tsai* does not anticipate independent claim 1, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 1, as amended, is allowable over *Tsai*, dependent claims 2, 4-9, and 20 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2, 4-9, and 20 contain all the features of independent claim 1. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002); *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 2, 4-9, and 20 are patentable over *Tsai*, the rejection of claims 2, 4-9, and 20 should be withdrawn and the claims allowed.

B. Claims 21-29

The Office Action rejects claims 21-29 under 35 U.S.C. §102(e) as allegedly being anticipated by *Tsai* (U.S. Patent No. 6,839,741). For at least the reasons set forth below, Applicant respectfully traverses the rejection to the extent not rendered moot by amendment.

**Independent claim 21**, as amended, recites:

21. A system of manipulating email messages:  
***a server configured for receiving a plurality of email messages for a user, for automatically deleting all attachments that cannot be viewed on an email device that can only provide the text of the email messages*** and  
a transmitter for transmitting the email messages to a user for viewing on the email device.

(Emphasis added).

Applicant respectfully submits that claim 21 is patentably distinct from the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue.

Applicant respectfully submits that the amendments to claim 21 have rendered the rejection moot. Applicant respectfully submits that independent claim 21, as amended, is allowable for at least the reason that *Tsai* does not disclose, teach, or suggest at least **a server configured for receiving a plurality of email messages for a user, for automatically deleting all attachments that cannot be viewed on an email device that can only provide the text of the email messages**. Even if, assuming for the sake of argument, *Tsai* discloses removal of attachments from an email message, *Tsai* fails to teach a server configured for receiving a plurality of email messages for a user, for automatically deleting all attachments that cannot be viewed on an email device that can only provide the text of the email messages. Therefore, *Tsai* does not anticipate independent claim 21, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 21, as amended, is allowable over *Tsai*, dependent claims 22-29 (which depend from independent claim 21) are allowable

as a matter of law for at least the reason that dependent claims 22-29 contain all the features of independent claim 21. Therefore, since dependent claims 22-29 are patentable over *Tsai*, the rejection of claims 22-29 should be withdrawn and the claims allowed.

**V. Rejections Under 35 U.S.C. §103(a)**

**A. Claim 3**

The Office Action rejects claim 3 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Tsai* (U.S. Patent No. 6,839,741) in view of *Cooper* (U.S. Patent No. 6,052,442). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1 is allowable over *Tsai*. Dependent claim 3 (which depends from independent claim 1) contains all the features of independent claim 1. *Cooper* does not make up for the deficiencies of *Tsai* noted above. Therefore, claim 3 is considered patentable over any combination of these documents for at least the reason that claim 3 includes allowable features of claim 1 as set forth above.

B. Claim 30

The Office Action rejects claim 30 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Tsai* (U.S. Patent No. 6,839,741) in view of *Cooper* (U.S. Patent No. 6,052,442). For at least the reasons set forth below, Applicant respectfully traverses the rejection to the extent not rendered moot by amendment.

**Independent claim 30**, as amended, recites:

30. A method of manipulating email messages with an email network appliance comprising:

***receiving an email message with an email network appliance that can only provide the text of a message, the email message having had attachments that cannot be viewed on the email network appliance automatically deleted such that the email message is text only;***

classifying the text only email message;

inserting the text only email message into a classification container;

presenting the classification container in a classification display section comprising at least two sections, each section containing one classification container;

presenting a text only email message in a classification container, wherein all presenting of the text only email message is performed off-line and

prompting a user to save a sent email message;

wherein the email network appliance comprises a handheld email Internet appliance connected to a public switched network via an RJ-11 interface, the appliance further comprising a keyboard and a scrollable line display capable of presenting at least six lines but no more than fifteen lines.

(Emphasis added).

Applicant respectfully submits that claim 30 is patentably distinct from the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features of the claim at issue.

Applicant respectfully submits that the amendments to claim 30 have rendered the rejection moot. Applicant respectfully submits that independent claim 30 is allowable for at least the reason that the combination of *Tsai* and *Cooper* does not disclose, teach, or suggest at least **receiving an email message with an email network appliance that can only provide the text of a message, the email message having had attachments that cannot be viewed on the email network appliance automatically deleted such that the email message is text only**. Even if, assuming for the sake of argument, *Tsai* discloses removal of attachments from an email message, *Tsai* fails to teach receiving an email message with an email network appliance that can only provide the text of a message, the email message having had attachments that cannot be viewed on the email network appliance automatically deleted such that the email message is text only. Even if, assuming for the sake of argument, *Cooper* discloses a scrollable display, *Cooper* fails to disclose receiving an email message with an email network appliance that can only provide the text of a message, the email message having had attachments that cannot be viewed on the email network appliance automatically deleted such that the email message is text only. As the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 30, the rejection should be withdrawn for at least that reason.



**VI. Miscellaneous Issues**

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

**CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-9 and 21-30 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

It is believed that no extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account No. 20-0778.

Respectfully submitted,

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